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IN THE

preme Court of the United States

October Term, 1972.

No. 72-423.

HADCO PRODUCTS, INC.,
Petitioner,

v.

WALTER KIDDE & COMPANY,
Respondent.

PLY BRIEF AND APPENDIX FOR PETITIONER.

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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1972.

No. 72-423.

HADCO PRODUCTS, INC.

Petitioner,

v.

WALTER KIDDE & COMPANY,

Respondent.

EPLY BRIEF AND APPENDIX FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

INTRODUCTION.

Petitioner seeks the Court's exercise of its sound judi-l discretion to issue the writ of certiorari in this case on o grounds set forth in Rule 19(b) of the Supreme Court ules; namely, because the Court of Appeals decision 11) is in express disagreement with decisions of the ourt of Customs and Patent Appeals and the Court of ppeals for the Ninth Circuit, and because the decision oses important questions of federal law which should be ttled by the Supreme Court.

THE COURT OF APPEALS DECISION IS IN CONF WITH DECISIONS OF THE COURT OF CUS AND PATENT APPEALS AND THE COUR APPEALS FOR THE NINTH CIRCUIT.

Conflict between the decision of the Court of A and the Court of Customs and Patent Appeals and th Circuit involves the specific manner in which the patentability set forth in § 103 of the Patent Act is applied to design patents. More particularly, it in the question of who, in the case of a design invent the mythical "person of ordinary skill" to which the makes reference, as well as the much broader quest to whether any design patent can meet the non-obvio qualification as interpreted and expounded in *Grah John Deere Co.*, 383 U. S. 1, 6 (1966).

The Court of Appeals' Opinion is openly critical District Judge for being influenced by the decision Court of Customs and Patent Appeals in *In re Lan* 356 F. 2d 1003; 53 C. C. P. A. 1158 (1966) which was lowed by the Ninth Circuit in *Schwinn Bicycle Co. v. G year Tire & Rubber Co.*, 444 F. 2d 295 (9 Cir., 1970). deed, the District Judge's decision was reversed prec on a point involving the meaning and application of More recently, the split of authority among the Court Appeals has come into sharper focus with the very re (October 16, 1972) decision in the Court of Appeals of District of Columbia in *Murray Fields v. Schuyler*, — 2d — (1972), which makes reference to the *Hadco, Lane Schwinn* and *John Deere* decisions and speaks of "the sible need for a different gloss on the obviousness stan in the case of design patents".[1]

1. This decision adds to the long list of post *John Deere* de cases in which the courts have uniformly found the designs u unpatentable.

ESPONDENT ITSELF RAISED THE CONSTITUTIONAL QUESTION IN THIS CASE.

While the case was pending before the District Court, spondent formally notified the Court and the Attorney neral of the United States that it would challenge the nstitutionality of the Design Patent Statute, 35 U. S. C. 1. In successfully seeking reversal of the judgment from e Court of Appeals, Respondent, in its brief before that urt, challenged the constitutionality of the Design Patent t (Brief for Appellant, p. 35):

> "In *Graham v. John Deere Co.*, 383 U. S. 1, 6, the Supreme Court, in discussing the import of Article 1, Section 8, clause 8 of the Constitution, reiterated the fundament:
>
> 'Innovation, *advancement,* and *things which add to the sum of useful knowledge* are inherent requisites in a patent system which by constitutional command must 'promote the progress of . . . useful Arts.' (Emphasis added.)'
>
> • • •
>
> If indeed the more subjective considerations of the District Court are proper under the controlling statutory mandate providing for design patents, 35 U. S. C. 171, then Kidde submits that such statute is unconstitutional. Its unconstitutionality is first shown by its apparent disregard of the requirement of promoting 'the progress of . . . useful Arts' as set forth in the explicit language of the Constitution. The statute so construed would also suffer from an unconstitutional vagueness since 'one's subjective appraisal' defies orderly definition.
>
> Perhaps Kidde's position is best stated by the following comment, which followed the Supreme Court decision of *Graham v. John Deere Co.*, at Note, *The 1966 Patent Cases: Creation of a Constitutional Standard,* 54 Geo. L. J. 1320, 1337-1339 (1966):
>
> 'The Court, the Congress, and the profession thought design patents constitutionally permissible for over one hundred years. Yet, the subject matter of design patents does not add to the sum of useful knowledge now deemed by the Court to be constitutionally required. The conclusion is inevitable—either the design patent statute is

> unconstitutional or the Court's constitutional requir
> of an advancement is incorrect.'
>
> The District Court erred by not satisfying the co
> tional standards for patentability in finding the patent i
> unobvious. If the standard applied by the Court was p
> such standard is unconstitutional."

The Court of Appeals, responding to the above a
ment that *Graham v. John Deere* set forth a higher co
tutional standard differing from and superseding the Pa
Statute, interpreted § 103 as requiring "synergism" in
sign cases as in mechanical cases. On this basis, the pa
in suit was found to be invalid. The same end resul
holding of invalidity—has been achieved in every d
patent case to reach a Court of Appeals since the decisi
Graham v. John Deere Co., supra. Indeed, as appears fr
the appended communication from Respondent's co
to the Court of Appeals, submitted after argument a
prior to the decision, this very point was emphasized a
principal reason for holding the Daum patent invalid. T
net effect is that Graham v. John Deere has been constr
and applied by the Courts of Appeals to nullify the d
patent statute in toto.

RESPONDENT MISREPRESENTS THE EVIDENCE.

At page 12 of Respondent's Brief it is stated:

"The patentee Daum defined the essence of his design as:

> 'Primary, silhouette. That is what makes it interesting to the eye.'"

This statement is false and the Daum quotation is taken out of context. Daum was not asked to define the "essence of his design." He was asked by Respondent's counsel on deposition to state whether everything shown in solid lines in his patent was novel and invented by him, to which he answered affirmatively. He then described the novel feature of his design, which included the "general proportions of the whole entire design" for which Respondent's counsel substituted the word "silhouette."

At the trial, Respondent's counsel attempted to define the quoted Daum testimony regarding the "silhouette" of the design as meaning a two-dimensional outline without more. Mr. Daum unequivocally rejected the suggestion that the primary feature of his design was a two-dimensional outline of the lighting fixture. He repeatedly insisted, as he had in his deposition, that when he used the term "silhouette" he meant the overall shape of the lighting fixture characterized by a six-sided roof and a six-sided lantern with a unique "Christmas tree" appearance. It is equally clear that the statement presented at page 12 of Respondent's Brief entirely misrepresents Mr. Daum's testimony in that it sets forth as his testimony that which he repeatedly refused to accept. His testimony on deposition and at the trial, attached in the Appendix hereto, fully supports this fact as does the following excerpted statement by Mr. Daum (521a-523a):

"Q. And you used before that the word pri
primarily silhouette. Is one of the most imp
things about your fixture its silhouette when it is
lighted against the sky, for example, with the
back of it. Its silhouette against the sky, is that
the important things about your fixture visually?"

"A. No, no."

Respondent's purpose in seeking to commit the
ventor Daum to the proposition that his design is prim
characterized by a specific two-dimensional outline of
lighting fixture was to justify a comparison of two-
sional representations of one view of the Daum des
the prior art lantern of Herwig No. 469.

At page 13 of Respondent's Brief appears wh
ports to be Figure 1 of the design patent in
imposed over the Herwig fixture, the chief item of th
art relied upon by Respondent. The impression
to be conveyed by this superimposition is that the
of the Daum design is identical to the silhouette of
fixture No. 469. The comparison is illusory because
sents a fragmented two-dimensional line drawing
imposed upon a three-dimensional photographic rep
tation. This illusion of identity figured prominently
in persuading the Court of Appeals that the Daum
patent was invalid.

In order to enable the Court to make a true compar
between the two designs presented by Respondent the
presented on the following pages two photographs,
showing at the right side an actual fixture made under
Daum patent in suit, and at the left side a fixture in all
spects similar to the Herwig catalog item No. 469
Respondent has selected as most pertinent. It is im
ately apparent that the mutilation of the Daum desig
presented in Respondent's Brief, eliminating the finial

HERWIG NO. 469 HADCO

HERWIG NO. 469 HADCO

portions of the vent cap of the Daum lighting fixture, removes dramatic points of difference between the two fixtures. It is also evident from a comparison of Respondent's Brief with the photographs that Respondent has heightened the illusion of similarity by altering the relative sizes of the two fixtures to produce the same scale. Scale is an important aspect in all design. It becomes very clear from the photographs that there is no significant similarity between the roof portions of the two fixtures and that the hexagonal cage of the patent is altogether different from the "cylindrical" cage of the Herwig fixture. (See the descriptive matter in the catalog pertaining to item No. 469.)

The Daum design is characterized by the very striking angularity of the finial, vent cap, roof, and cage, as is clearly shown in Figure 2 of the Daum patent, whereas, in the Herwig fixture, all elements, from top to bottom, are circular in cross section. The roof edges of the Daum design not only rise and fall in their sinusoidal curvature but have triangular accents raised out of the normal plane of the roof and forming a distinctive pattern. By contrast, the roof of the Herwig fixture is simply notched at its peripheral edge to form semi-circular serrations in the plane of the roof. The representation of the Herwig fixture in Respondent's Brief by reason of its vagueness of illustration gives a false impression as to the true character of the roof edge treatment.

The suggestion of identity of the cage elements of the two fixtures in Respondent's altered representations is clearly erroneous and quite misleading.[2] As the catalog

2. Both opinions below mistakenly refer to Herwig fixture No. 469 as having a "four sided" cage (A 14, A 30). Actually, all parts thereof are round, as evidenced by the catalog description and by the appended testimony of Daum. The photographs herein confirm what the roof and cage of the Herwig fixture would look like if viewed in perspective.

states, the Herwig cage is "cylindrical" with four verti framing elements, whereas the cage in the Daum desig hexagonal and flat between the six vertical framing ements. In fact, the photographs amply justify the D trict Judge's characterization of the prior art as "squat (A 34) as compared to the Daum design.

It is apparent that the dramatic silhouette compari of the Daum design with the prior art which has been important part of Respondent's position throughout t case is based upon an *incomplete* and *misleadi* presentation.

Inherent in the decision below and in numerous ca rendering design patents invalid, either upon summa judgment or upon reversal of the District Court judgme of validity, is the abandonment of reliance upon evidentia findings of fact dealing with level of skill and obvious in design patent cases.

PROPER ADMINISTRATION OF THE DESIGN PA ENT SYSTEM REQUIRES DECISION BY TH COURT.

Respondent would persuade the Court that this is "commonplace action" and "an ordinary patent case This is not, however, the position Respondent took befo the Courts below. On the contrary, Respondent served t appended formal notice upon the Courts and upon t Attorney General of the United States that the constit tionality of the design patent law was at stake.

The only way in which the term "commonplace" c be applied to the present case is in that it has becom commonplace for the Courts of Appeals to invalidate desi patents. Since the decision of the Supreme Court *Graham v. John Deere Co., supra,* the invalidation of desi patents has in fact become so commonplace as to ca

both Respondent and the District Court to question whether any design can be found patentable under the Constitution.

It is quite clear that the Court of Appeals, in reversing the District Court and holding the Daum patent invalid, was conscious of the questions that have been raised regarding the demise of design patents (A 12, fn. 29). The District Court flatly questioned whether any design patent could be constitutional. No Court of Appeals has held a design patent valid since the decision of *Graham v. John Deere*. Still, inventors continue to rely upon the promise offered by the design patent statute and by the Patent Office in administering that statute. The question that has been raised deserves an answer at this time.

Respectfully submitted,

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Appendix.

NOTICE UNDER RULE 44.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

APPEAL No. 19,068

WALTER KIDDE & CO., INC.,
Appellant

v.

HADCO PRODUCTS, INC.,
Appellee

Notice Under Rule 44 of the Federal Rules of Appellate Procedure.

Pursuant to Rule 44 of the Federal Rules of Appellate Procedure, Walter Kidde & Co., Inc., the above-named appellant, hereby gives notice that it will draw into question the constitutionality of 35 U. S. C. § 171, in the above-captioned appeal.

Respectfully submitted,

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LETTER TO THE CLERK OF THE U. S. COURT APPEALS FOR THE THIRD CIRCUIT.

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Re: Hadco Products, Inc. v. Walter Kidde & Company, Appeal No. 19068 in the United States Court of Appeals for the Third Circuit

Dear Mr. Quinn:

On April 2, 1971, the above-identified appeal was ar to the Court of Appeals, Judges Seitz, Forman and Aldi

No decision has as yet been rendered by the Court of Appeals.

At footnote 2 on page 4 of appellant's Reply Brief, there is a listing of all of the Court of Appeals decisions dealing with design patents subsequent to *Graham v. John Deere Co.* Without exception, each such Court of Appeals decision has held the patent in suit to be invalid.

I have just learned that on March 16, 1972, the Court of Appeals for the Seventh Circuit in *Frantz Mfg. Co. v. Phenix Mfg. Co.* held invalid design patent 194,094. This decision has not yet been reported. This patent had previously been held valid by the United States District Court for the Eastern District of Wisconsin in *Frantz Manufacturing Co. v. Phenix Manufacturing Co.*, 307 F. Supp. 99 (E. D. Wisc., 1970).

Accordingly, the Court of Appeals decision of the Seventh Circuit should be added to the aforesaid footnote 2.

I am enclosing herewith a copy of this letter for each of Judges Seitz, Forman, and Aldisert.

A copy of this letter has been delivered to Woodcock, Washburn, Kurtz & Mackiewicz, Esqs., attorneys for appellee.

Respectfully submitted,

ARTHUR H. SEIDEL,
Arthur H. Seidel,
Attorney for Appellant.

AHS:c
cc: Robert B. Washburn, Esq.

EXCERPTS FROM DAUM TESTIMONY.

H. A. DAUM—DIRECT.

(464a)

The Witness: Murlin. Nothing fulfills the req ment there.

19, the same; 20, the same; 21, the same; 22, 2 the same; 25, the same; 26, the same; 27, the same

By Mr. Paul:

Q. Stop for a moment at 27.

Are you personally familiar with the Herwig fix that are shown on Page 27 in this book?

A. I certainly am.

Q. Let me call your attention on Page 26 to No. at the left. Do you see that?

A. Yes.

Q. And to Nos. 469 and 470 on Page 27.

A. Yes.

Q. Are you familiar with those particular fixtures

A. They are the same fixtures.

Q. What is the shape of the roof?

A. Round.

Q. What is the shape of the cage?

A. Round.

Q. The cage?

A. Is round.

Q. Oh! How many sides to it.

A. It has four divisions in a round circle.

(465a)

Q. But they are mounted in a circle, are they not?

A. It tells you right here. It says 4½ inches. cylinder size is 2½ by 5½ by 5¾, and that's a cone-sha cylinder.

Q. Then the cage?

A. The cage is definitely a cylinder too.

Q. The roof is conical?

A. The roof is conical in shape (indicating).

Mr. Seidel: Your Honor——

The Witness: And it is round.

Mr. Seidel: What he just testified to, it's impossible. A cylinder, as I understand it, is a solid of constant diameter. That can't possibly have a constant diameter, Mr. Paul.

The Court: Under 470 and describing it, it says: "Cylinder size 2½ by 5½ by 5¾."

The Witness: It gives three dimensions.

Mr. Seidel: That's a misuse of the word cylinder if there ever was one, Your Honor, because a cylinder is a constant diameter.

The Court: I didn't print the book, and neither did you.

Mr. Seidel: O. K. Thank you.

* * *

H. A. Daum—Cross.

* * *

(521a)

how many years would you say? Twenty, thirty years?

A. I would say somewhere in there.

Q. Would you say that is an unusual length of time for an outdoor fixture to be sold, the same style?

A. No, not necessarily.

Q. What?

A. Not necessarily.

Q. Not necessarily.

Now, in your testimony at—I will give you the pag
counsel can verify—Page 170 of your deposition of Sep
ber 9, 1969, you stated, and I will refresh your recollect

"Silhouette—and you were then referring to y
fixture as shown in your patent—silhouette, th
what makes it interesting to the eye."

Do you recall that statement?

A. Yes, I do.

Q. And you used before that the word primarily,
marily silhouette.

Is one of the most important things about your fi
its silhouette when it is highlighted against the sky,
example, with the sun in back of it? Its silhouette ag
the sky, is that one of the important things about your
ture visually?

(522a)

A. No, no.

Q. Well, what did you mean by: "Primarily silhou
that's what makes it interesting to the eye"?

A. Can I answer that?

Q. Yes.

A. It was the general shape, the contour shape wh
used the word possibly improper for an attorney.

I use it as a silhouette giving a shape to that thing
lar to, or if you want to call it, a Christmas tree, if
want to call it that, but I did not design the silhouette
I designed a silhouette, then we would have had a
fixture, and that would have been all there was to it.

Q. By "silhouette," do you mean profile, the ou
configuration?

A. Yes.

Q. That's important?

A. Yes, that shape.

Q. That outside shape?

A. Its shape, that's part of——

Q. You will agree with me that if somebody was at a distance and couldn't see the details such as the triangular accents at the periphery of the roof or the triangular accents at the periphery of the vent cap or the simulated ventilators, and if there was a bright light in back of the fixture such as

* * *

(523a)

the sun, they could see the profile of the fixture or the silhouette of the fixture? That's what you are talking about, isn't it?

A. Can I answer that?

Q. Yes.

A. I mean in my own words, without saying yes or no?

Q. First give the answer to my question and then you can qualify it if you like.

A. I don't agree with your question.

Q. You don't agree with that?

A. No.